SUPREME COURT, U. S.

Office Supreme Court, U.S.
FILED
JUL 6 1962
JOHN F. DAVIS, CLERK

No. 233

In the Supreme Court of the United States

OCTOBER TERM 1962

EDWIN A. KAAKINEN and KAAKINEN FISH COMPANY,
Petitioners,

vs.

THE PEELERS COMPANY, a partnership.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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THE ARGUS PRESS, SEATTLE, WASHINGTON

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

Petitioners, Edwin A. Kaakinen and Kaakinen Fish Company, pray that a writ of certiorari issue to review the judgment of the Circuit Court of Appeals for the Ninth Circuit affirming the decision of the District Court for the Western District of Washington, Southern Division, Appellant's Petition for a Rehearing having been denied.

OPINIONS OF DISTRICT AND APPELLATE COURTS

At the close of the trial the District Court requested that both plaintiff and defendants file proposed findings of fact and conclusions of law, as well as briefs. In a short memorandum opinion printed in the Record on Appeal at page 138 and in 126 USPQ 42, all of plaintiff's proposed findings and conclusions 1 through 50,

were adopted by the District Court with minor modifications and additions, such findings being printed in the Record on Appeal at page 144.

On appeal to the Court of Appeals for the Ninth Circuit the original judgment or decree by Wollenberg, District Judge, was dated and entered January 22, 1962, 301 F.2d 170, 132 USPQ 307.

A petition for rehearing of the original decision by the Circuit Court was filed on February 19, 1962, requesting a rehearing en banc on the question of conflict with other decisions of the Ninth Circuit Court of Appeals and this petition for rehearing was denied on April 10, 1962, by an opinion of Wollenberg, District Judge, reported at 301 F.2d 173 and 133 USPQ 298.

The original decision of the Circuit Court and the decision on rehearing are printed in the appendix to this petition.

JURISDICTION

Jurisdiction of this Court is invoked under 28 U.S.C. 1254(1) and 28 U.S.C. 2101(c).

QUESTIONS PRESENTED

1. May a Court base its determination of invention and infringement of a patent solely on the success and operation of a commercial machine of the patent owner when that commercial machine is different in construction from the machine described and shown in the patent, and the machine of the patent was admittedly unsuccessful?

2. Does processing of a different commodity consti-

tute such a "new use" of an assembly of old parts as to eliminate the necessity of complying with the requirement of the Supreme Court in *The Great A & P Tea Co. v. Supermarket Equipment Corporation*, 340 U.S. 147, that the old parts or elements must perform an additional or different function in the combination than they perform out of it to constitute invention?

3. Is the intent of Rule 52(a) of the Federal Rules of Civil Procedure fulfilled in patent cases by findings of fact which recite simply legal tenets of patentability without recitation of any factual basis found in the particular case to support such tenets?

RULE INVOLVED

The following portion of a Rule of Federal Civil Procedure is pertinent to question 3:

FINDINGS BY THE COURT

"Rule 52(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment."

STATEMENT OF THE CASE

The basis for jurisdiction of this case by the District Court is 28 U.S.C. 1338(a), this case having been a suit for patent infringement under 35 U.S.C. 281. Defendant-petitioners also brought a counterclaim for a declaratory judgment based on 28 U.S.C. 2201 and the District Court venue was proper in accordance with 28 U.S.C. 1400.

The Peelers Company, owner of the following three patents, has asserted that shrimp peeling machines de-

signed by Skrmetta and purchased and used by defendants-petitioners infringe certain claims of such patents.

No. 2,429,828 dated Oct. 28, 1947; filed July 25, 1944, for Shrimp Peeler.

No. 2,537,355 dated Jan. 9, 1951; filed Dec. 7, 1947, for Machine for Peeling Shrimp

No. 2,574,044 dated Nov. 6, 1951; filed April 1, 1946, for Shrimp Peeling Machine.

The shrimp peeler of the first patent, 2,429,828, application filed July 25, 1944, was the first machine built to completion (R. 717) and it was dismantled and the parts discarded (R. 720).

The next shrimp peeling machine constructed was that of patent 2,574,044, application filed April 1, 1946 (R. 720) and it also was dismantled and parts discarded (R. 720).

No evidence was introduced that the shrimp peeling machine of patent 2,537,355, application filed December 7, 1947, was ever constructed.

Thus, the efforts of the Peelers Company to produce a commercially successful shrimp peeling machine during the years 1944 to 1948 were unfruitful, such efforts resulting only in 1944 in the discarded machine of patent 2,429,828; in 1946 in the discarded machine of patent 2,574,044 and in 1947 in the inoperative and insufficient concept of the machine disclosed in patent 2,537,355.

In about May of 1949 a shrimp peeling machine different from all the machines disclosed in the patents involved in suit was offered to the industry by the predecessor to the Peelers Company, owner of the patents

in suit. By 1959 one hundred twenty-four of these commercial machines were on lease in the United States. This commercial machine was immediately successful in 1949, and since then has virtually eliminated hand peeling in the shrimp canneries.[1] These commercial shrimp peeling machines were alike[2] and may be considered as a single machine,[3] in contrast to the three distinct machines of the three patents in suit which are different from each other and from the commercial machine, all of which were unsuccessful. Actually, this commercial machine is substantially like the machine disclosed in the later patent 2,778,055, of the same ownership, not involved in the suit.

Inventiveness of the *machines of the patents in suit* was completely predicated by the Trial Court on *results achieved* by the *commercial* machines of different design. Those results were broadly labor-saving over hand peeling and increased production.[4]

Also, infringement of the three patents in suit was established collectively by comparison of a Skrmetta machine, not with any machine disclosed in any one of the patents in suit, but with the commercial machine.[5]

In this suit defenses of lack of invention over prior art patents, double-patenting between patents 2,429,828 and 2,574,044, and between patents 2,574,044 and 2,537,355, and insufficiency of disclosure of patent 2,537,355 were asserted.

[1]Finding of Fact 20.

[2]Finding of Fact 19.

[3]Finding of Fact 18.

[4]Finding of Fact 21.

[5]Findings of Fact 40, 41, 42 and 43.

The Court adopted 52 Findings of Fact presented by counsel for plaintiff, with minor changes. The findings can be classified in groups, as follows:

Eight general findings, Nos. 1 to 8.

Thirteen "shrimp" findings, Nos. 10 to 15, 29 to 35.

Seven infringement findings, Nos. 36 to 39, 44, 50, 52.

Thirteen commercial machine findings, Nos. 16 to 21, 25, 27, 28, 40 to 43.

Four "new combination" findings, Nos. 9, 22, 23, 24.

One "pioneer invention" finding, No. 26.

One "double patenting" finding, No. 51.

One "sufficient disclosure" finding, No. 46.

Four "prior art" findings, Nos. 45, 47, 48, 49.

Although three patents are involved in this suit and twenty-one of their claims were alleged and held to be infringed, neither the District Court, nor the Circuit Court in the opinions or in the findings of fact on "new combination" discussed or attempted to identify what was considered to be a "new combination" with respect to the issue of invention. There was no discussion or identification in the opinions or findings as to what was considered to be the "invention" of any of the patents or representative claims in suit. Moreover, no attempt was made to differentiate between the purported inventions of the three patents. Neither was there any attempt to explain how any "invention" of any of the patents in suit contributed to, or was responsible for, the success of the commercial machine.

Similarly, the opinions and findings of fact relating to "prior art" patents did not discuss any of the ma-

chines or features of such prior art machines, but commented only to the general effect that the prior art did not anticipate the claims of the patents in suit,[6] that these prior art machines were intended for picking or peeling products other than shrimp,[7] and that these prior patents did not teach successful shrimp-peeling combinations.[8]

In Appellants' Petition for Rehearing before the Circuit Court, Ground 1 stated

> "Should this case be remanded with directions for the Trial Court to make factual findings as to the prior art and the separate inventive improvement of each of the three patents in suit?"

In denying rehearing District Judge Wollenberg, speaking for the Court of Appeals, stated,

> "The findings are detailed and complete in respect to prior art."

In his original decision on appeal Judge Wollenberg stated,

> "The trial court, in its holding of validity of the claims over prior art, correctly analyzed the existing patents presented as a 'prior art' defense. * * * Appellants rely upon many references to sustain a 'prior art' defense. Corn-huskers, rock and gravel strainers, peanut-stemmers, and onion skinners are some of the other machines referenced by appellants."

Both in briefs and argument before the District Court and the Appellate Court defendants-petitioners

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[6]Finding of Fact 45.

[7]Finding of Fact 47.

[8]Findings of Fact 47, 48 and 49.

analyzed the construction of various prior art patents, most of which were not cited by the Patent Office against the applications resulting in those patents, and pointed out to the Court how the features of the various claims were shown and described by these prior patents.

The decision of the Circuit Court stated,

> "In respect to the validity of the invention over prior art the trial court found a new combination of old elements,"

and has made reference to Findings of Fact 21, 24, 26 and 49 of the District Court. These findings do not discuss either the nature of the "prior art," or the structure of the new combination, or of what old elements such asserted new combination is composed, or in which of the three patents in suit it is disclosed or claimed.

The Appellate Court further stated,

> "The trial court, in its holding of validity of the claims over prior art, correctly analyzed the existing patents presented as a 'prior art' defense. The evidence presented supports the findings of the court in this regard."

Neither the opinion or findings of fact of the District Court contains an analysis of any machine of any existing prior art patent and the Appellate Court does not indicate to what "evidence" it has reference in the above statement.

With respect to the Peelers commercial machine the Appellate Court stated,

> "Machines embodying the combination of appellee's machines revolutionized the shrimp canneries, bringing new results in yields and upgrading the shrimp with a consequent rise in its market value.

> * * * The evidence shows that the success of the machines here was substantial and immediate."

These statements are made with reference to the Peelers commercial machines because the three machines shown in the drawings and disclosed in the three patents in suit were unsuccessful.

REASONS FOR GRANTING CERTIORARI

1. At the present time two other suits in different United States District Courts are pending in which the Peelers Company has charged infringement of the three patents here in issue by Skrmetta machines, and a third suit by the Peelers Company against other parties is pending in the same District Court in which the present suit was tried.

In the case of *The Peelers Company v. Paul C. Skrmetta, et al.*, D.C. E.D. Louisiana, C.A. 7294, Judge West, who has never tried a patent case, has expressed the opinion that the decision in this case in D.C. W.D. Washington and in the 9th Circuit has settled all the issues in the Louisiana case even though it is not *res judicata* because of the difference in parties. In the case of *The Peelers Company v. King Crab, Inc.*, D.C. Alaska, C.A. A-32-62, the Court has granted a preliminary injunction against King Crab, Inc., on the basis of the decisions in this case although again *res judicata* does not apply. If the basis of the decisions by the District Court and the Appellate Court in this case are improper, therefore, the errors inherent in those decisions are likely to be multiplied by other courts following such improper precedents, resulting in far-reaching injustice.

2. A complaint has been issued by the Federal Trade Commission against the Peelers Company, Docket No. 7887, involving practices relating to its leases of shrimp-peeling machines to virtually the entire United States shrimp industry. If the validity of the patents here in suit has been improperly evaluated by the Courts and such patents actually are invalid, that fact would be highly pertinent to the issues of the Federal Trade Commission proceedings.

3. Each patent represents a separate and independent monopoly and the public is entitled to know the boundaries and duration of each patent monopoly. Patent 2,429,828 will expire October 28, 1964; patent 2,537,355 will expire January 9, 1968, and patent 2,574,044 will expire November 6, 1968. To give general blanket rulings on invention of all three patents without discrimination between them, where the subject matter claimed is very similar, effectively extends the life of the patent first to expire for a period of more than four years and of the second patent ten months, by judicial action, which tends to discourage, instead of to encourage, invention.

4. There is generally a split of authority on whether the finding of only "ultimate facts" as to patentability and invention constitute sufficient compliance with Rule 52(a) of the Federal Rules of Civil Procedure. This Court has given some guides to the nature of findings of fact which should be made to provide proper detail in a railroad reorganization case (*Ecker v. Western Pacific Railroad Corp.*, [illegible] U.S. 448, and *Group of Institutional Investors v. Chicago Milwaukee*

St. Paul & Pacific Railroad Company, 318 U.S. 523), in a drainage district reorganization plan (*Kelly et al. v. Everglades Drainage District*, 319 U.S. 419) and in a gift tax case (*Commissioner of Internal Revenue v. Duberstein*, 363 U.S. 278), but the first two of these cases involved special statutes and the last case, while raising the problem, is not helpful in a *patent* case.

5. The ruling in this case that patents for picking or peeling articles other than shrimp are disqualified as prior art pertinent to show that old elements of the machines of the patents in suit perform no new or different function, is contrary to the proper application of the doctrine of *The Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corp.*, 340 U.S. 147. Moreover, such ruling is inconsistent with the practice of the Patent Office in this regard. A ruling by the Supreme Court on this point would promote consistency between the Courts and the Patent Office.

6. It is believed that the principle expressed by the Supreme Court in the case of *Leishman v. Associated Wholesale Electric Company*, 318 U.S. 203, applies here, namely, that

> "We granted certiorari to settle the important question of practice presented under the Rules of Civil Procedure."

It is believed that the practice as to the nature of findings of fact appropriate in patent cases is very important in order to enable an Appellate Court to review satisfactorily the decision of the Trial Court.

ARGUMENT

Question One

Throughout the findings, conclusions and decision of the District Court and the decisions of the Appellate Court on original hearing, and on rehearing, the three *separate and complete* shrimp peeling machines of the three separate patents have been disregarded. Complete reliance for patentability and infringement of the patents has been predicated on the success of a *commercial* machine of the patent owners which is different from each of the three machines of the patents in suit.

With respect to the question of infringement the Trial Court based his findings on a comparison of the performance of the commercial machine with the performance of the defendants-petitioners' Skrmetta machine without any determination as to the similarity between the successful commercial machine and the machines of the three patents in suit, all of which were failures.

The lower Court adopted Finding of Fact 16:

> "Prior to 1949 attempts had been made to design machines for the peeling of shrimp, but no successful machines were devised and the canneries continued to employ workers for the hand peeling of shrimp."

The Circuit Court Opinion stated:

> "Until 1949 the peeling of shrimp was all done by hand * * * Prior to that from 1944 attempts to pick shrimp by machine had not been successful in eliminating hand picking."

On appeal defendants-petitioners asserted as one specification of error.

"14. Because appellee's commercial machine is essentially the machine disclosed in appellee's patent 2,778,055 and not the machine disclosed in any of the patents in suit, the District Court erred in comparing appellee's commercial machine with appellants' Skrmetta machine in evaluating infringement of the *patents* in suit in findings 37, 41, 42, 43 and 52."

The Appellate Court ruled specifically on this point, stating

"A review of the evidence on this point, which includes a test in the plant of the machines, and the testimony of an expert witness, Strasburger, led the District Court to make findings of fact as to infringement, and there is no error of law in this regard."

The Court then cited in a footnote facts 39, 41 and 42 pertaining to the comparative tests of the Peelers' *commercial* machine with the Skrmetta machine.

No cases in point decided by the United States Supreme Court have been found. The present case, however, is inconsistent with other lower court decisions, including decisions in the Ninth Circuit. The case of *S. S. Kresge Company v. Davies*, 8 Cir. 1940, 112 F.2d 708, stated,

"In considering the question of infringement, we must compare the accused product or device with the teaching of the patent in suit *as disclosed by the specifications and claims*, rather than with plaintiff's commercial device." (Italics supplied)

In *Magnavox v. Hart & Reno, et al.*, 9 Cir. 1934, 73 F.2d 433, the Court stated,

"it is axiomatic in the patent law that infringe-

ment depends, not upon what is manufactured or sold by the patentee, but upon what he has *patented.*"

This Court then quoted with approval from the previous Ninth Circuit Court case, as follows:

> "In Grand Rapids Show Case Co. v. Weber Show Case & Fixture Co., 38 F.(2d) 730, 731, certiorari denied, 281 U.S. 767, 50 S. Ct. 465, 74 L.Ed. 1174, the late Judge Dietrich, of this court, said: 'It may be true that the cases which appellant (the patentee) actually manufactures and markets much more closely resemble the defendant's structure, but its suit is necessarily predicated, not upon what it manufactures, but upon what it has patented.'"

Presumably in that case certiorari was denied because the case stated what the United States Supreme Court then believed to be the correct law, but in the present case the same Circuit has now reversed its point of view.

The cases of *Kresge Company v. Davies, Magnavox Co. v. Hart & Reno* and *Grand Rapids Show Case Co. v. Weber* were relied upon in *General Electric Co. v. Jewel Incandescent Lamp Co.*, D.C. D. N.J. 1942, 47 F.S. 818, 55 USPQ 474. To the same effect are *Tampax Incorporated v. The Personal Products Corporation*, D.C.E.D. N.Y. 1941, 38 F.S. 663, 49 USPQ 311; *Drakoff v. Morays Manufacturing Co., Inc.*, D.C.E.D. N.Y. 1939, 30 F.S. 268, 43 USPQ 236, and *Hartford-Empire Co. v. Obear Nester Glass Co.*, 8 Cir. 1930, 39 F.2d 769, 4 USPQ 483.

Correspondingly, indicia of inventiveness should not be imputed to the "inventions" of the patents in suit

when the commercial success as recognized by the Court of Appeals, as well as by the District Court, was *only* that of the commercial machine and not any of the machines disclosed in the patents in suit.

> "Thus, commercial success becomes insignificant because it was achieved as a result of plaintiff's commercial sheet and not the sheet described in their claim." *Kromer, et al. v. Riegel Textile Corp.*, 7 Cir. 1955, 227 F.2d 741, 107 USPQ 317.

The machines of the patents in suit developed in 1944, 1946 and 1947, respectively, cannot be held to be inventive on the basis of the performance of the Peelers 1949 commercial machine. As the Circuit Court stated in this case,

> "The first successful machine came into use in the year 1949. Prior to that from 1944 attempts to pick shrimp by machine had not been successful in eliminating hand picking."

In *B. F. Goodrich Co. v. United States Rubber Company*, 4 Cir. 1957, 244 F.2d 468, 113 USPQ 393, the Circuit Court pointed out that the action of the Patent Office seemed to have been influenced by the claim of commercial success, but that this commercial success

> "was not due to the simple combination taught by the patent but to changes subsequently made."

It is certainly to be presumed that the success of the Peelers commercial machine was due to changes made over the unsuccessful patented machines.

Neither the District Court nor the Appellate Court discusses the comparative structures of the three machines of the three patents in suit, or of the commercial machine. Did the court reason that since the Peel-

ers *commercial* machine had been of benefit to the industry it should be protected by holding the patents in suit valid and infringed without investigating the relationship between the machines of the several patents and the commercial machine? The situation is, of course, much more complicated when one tries to correlate a commercial machine with *three different* machines of *three different patents* in suit, especially when the commercial machine is most similar to the machine disclosed in a *fourth* patent not in suit.

Question Two

It has generally been considered in patent law that a new use of an old device did not make that *device* patentable *again* because of the new use. Thus, a nutcracker could not be repatented as a crab cracking machine simply because the same device was used to crack crabs.

The general statement of the Appellate Court in the original decision raises a serious question as to the attitude of that Court on this "new use" doctrine. The Court held,

> "The evidence, therefore, clearly demonstrated the validity of the patents in suit and was summed up in the trial court's Finding of Fact No. 26: 'The inventions of the patents in suit are primary and pioneer inventions in the *art of shrimp processing.*'" (Italics supplied)

As a preface to this statement, the Appellate Court said

> "Appellants rely upon many references to sustain a 'prior art' defense. Corn-huskers, rock and gravel strainers, peanut stemmers, and onion skin-

> ners are some of the other machines referenced by appellants."

The inference is, therefore, that the "prior art" was discarded as being pertinent because it did not relate to "shrimp processing."

The fact is that *all* of the claims of *all* of the patents in issue relate to picking or peeling *machines*. Consequently, the decision of *Concrete Appliances Company et al. v. Gomery et al.*, 269 U.S. 177, is pertinent. In that case the Court found that there was no invention in using, for handling "wet" concrete, appliances which previously had been used

> "for the elevation and distribution of mobile substances, such as grain and coal, which involved, both in principle and in practical detail, all the elements described in the Callahan claims."

Apparently, in the present case there was no attention given to individual elements of the machines defined in the claims.

There is also the important circumstance in this case that corn huskers and rock and gravel strainers and other types of picking and peeling machines were cited by the Patent Office in rejecting claims of an application of one of the patents in suit, and as a result of this rejection the applicant cancelled the claims. It appears, therefore, that the practice which has been established by the decision of the Ninth Circuit Court in this case is contrary to the practice in the Patent Office on the particular art here involved.

The finding of the District Court most pertinent to this question is,

"24. The new combinations of the patent claims here in issue produced new functions and new results *in the peeling of shrimp;* the elements of these combinations are so arranged and so cooperate as to perform functionally more than the mere elimination of hand labor." (Italics supplied)

In the case of *The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,* 340 U.S. 147, the Supreme Court confirmed the requirement in the previous case of *Lincoln Engineering Co. v. Stewart-Warner Corp.,* 303 U.S. 545, 549, 450 O.G. 3. that

> "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."

The Court then went on to say that,

> "only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable."

In Finding No. 24 the District Court stated that the elements "performed functionally more than the mere elimination of hand labor." The Court apparently felt that it was unnecessary to find as a basis of "invention" that

> "*old elements* which made up this device perform any *additional or different function in the combination* than they perform out of it," (Italics supplied)

presumably because of the alleged "new use." The Supreme Court continued,

> "Two and two have been added together, and still they make only four. * * * This patentee has

> added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly."

The Court appears to feel that the fact that the machine was devised to process *shrimp,* rather than some other commodity, excused the Court from complying with the requirements of the Supreme Court in the *A & P* case.

The District Court also found in this case,

> "22. The new combinations covered by the patent claims here in issue overcame problems of long-standing in the shrimp peeling art,"

but in the *A & P v. Supermarket* case the Supreme Court stated,

> "The court of appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability."

As has been pointed out earlier in this petition, the "commercial success" and "overcoming of problems" was *not* accomplished by any of the machines of the patents in suit, but by the *different* commercial machine.

It is respectfully submitted that the Supreme Court should consider whether such "new use" situation constitutes an exception to the principles applied by the Supreme Court in the *A & P v. Supermarket* case. In the absence of such a review by the Supreme Court it would appear that this decision of the Ninth Circuit will be used as authority for future rulings that utilizing a collection of old elements for processing a differ-

ent type of product would constitute an exception to the *A & P* decision doctrine.

The importance of review by the Supreme Court is increased by the fact that the decision of the Ninth Circuit Court in this case is contrary to the position that has been taken by the Patent Office. It is believed that the reason that the claims of the patents here in suit were granted was inadvertence on the part of the Examiner in failing to discover patents called to the attention of the District Court by defendants-petitioners, but if the decision of the Ninth Circuit Court has established a proper exception to the rule of the *A & P v. Supermarket* case decided by the Supreme Court, this rule should also be followed by the Patent Office.

Question Three

The only information of consequence which can be gleaned from the findings of fact, conclusions and opinion of the District Court and from the original and rehearing opinions of the Circuit Court is that the patents in suit relate to shrimp peeling machines. What their construction is, what the construction of prior art devices is and what differences, if any, are present in each machine of each of the three patents in suit does not appear.

Of all the Findings of Fact only five relate to "invention" of the claims of the patents in issue, as follows:

> "9. The inventions covered by the patent claims here in issue are new combinations of elements, which elements, considered singly, are generally old. Shrimp peeling machines embodying these inventions were the first machines ever successfully

used in the automatic bulk peeling of shrimp in shrimp canneries.

"22. The new combinations covered by the patent claims here in issue overcame problems of long-standing in the shrimp peeling art.

"23. Previously proposed machines for automatically peeling large volumes of shrimp were unsuccessful and plaintiff's new combinations covered by the patent claims here in issue succeeded where others had previously failed.

"24. The new combinations of the patent claims here in issue produced new functions and new results in the peeling of shrimp; the elements of these combinations are so arranged and so cooperate as to perform functionally more than the mere elimination of hand labor.

"26. The inventions of the patents in suit are primary and pioneer inventions in the art of shrimp processing."

Only one finding and one conclusion are directed to the issue of double patenting as between patents 3,537,355 and 2,574,044, no finding being made as to double patenting between patents 2,429,828 and 2,574,044.

"51. The patents Nos. 2,537,355 and 2,574,044 are patentably distinct from each other.

"2. The defense of double patenting as advanced by defendant in this case must be denied because the patentees of the '044 and '355 patents are different and the claims in question express inventions which are patentably distinct from each other."

Only one Finding of Fact relates to the issue of insufficient disclosure of patent 2,537,355.

"46. Defendant's assertion that the '355 patent contains an inoperative and insufficient disclosure is not supported by the evidence. The disclosure of the '355 patent is sufficient to enable a person skilled in the art to make and use the inventions therein described and claimed for the objectives and purposes therein stated."

With reference to whether findings making general statements of ultimate fact are sufficient compliance with Rule 52(a) in patent cases there is no mention in the Memorandum Decision of the District Court (R. 138), its Findings of Fact and Conclusions of Law (R. 141 to 169), and the Decisions of the Appellate Court, original and on rehearing, as to the subject matter claimed by patent 2,429,828 in suit. The only reference to the claimed subject matter of patents 2,574,044 and 2,537,355 is to both of them simultaneously that claims of these patents refer to a roll (Finding of Fact 38), or a roller (Finding of Fact 39), and it may be inferred that rollers in some way form peeling channels and that pressure fingers of some type are somehow involved (Finding of Fact 41).

There is no discussion of the structure of any of the prior art patents with respect to which the District Court adopted Findings 45, 47, 48 and 49.

The only United States Supreme Court case found ruling in any way on findings of fact in a patent case is that of *United States v. Robert Esnault-Pelterie*, 299 U.S. 201, in which the case was remanded to the Court of Claims on the ground that that Court had failed to make specific findings on the main issues concerning validity and infringement. This Court considered the

case again in *United States v. Robert-Esnault-Pelterie*, 303 U.S. 26, in which the Court by inference approved the procedure of the Court of Claims making findings in addition to those of ultimate fact by saying,

> "We may, of course, inquire whether the subordinate or circumstantial findings made by the court below necessarily override its ultimate findings of fact and show that the judgment in point of law is not sustainable."

Such an inquiry would be impossible if there were no subordinate findings, but the decision does not state that such subordinate findings must be made, to comply with the Federal Rules of Civil Procedure, Rule 52(a).

In the case of *The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, the Court stated,

> "The district court explicitly found that each element in this device was known to prior art."

Similarly, in the present case the Trial Court found,

> "The inventions covered by the patent claims here in issue are new combinations of elements which elements, considered singly, are generally old."

What the "elements" were and what the "new combinations" were for *each* of the patents in suit is not disclosed by the findings or opinion of the Trial Court or of the Circuit Court. In the *A & P* case the Supreme Court pointed out that,

> "Neither court below has made any finding that old elements which made up this device perform any additional or different function in the combination than they perform out of it."

In the instant case various findings point out the virtues of mechanization of shrimp peeling by the commercial machine, but there is nothing said about the way elements of the devices cooperate or function differently from elements in prior devices.

The uncertainty even in the same circuit is illustrated by the following statement giving one point of view,

> "Insofar as the district court's findings of fact make no specific mention of any particular prior art, but merely refer to the Dorey patent in suit as being 'new and useful and is not anticipated by the prior art,' they are clearly erroneous. 28 U.S. C.A. Rule 52(a)." *Enterprise Railway Equipment Company v. Keystone Railway Equipment Company,* 7 Cir. 1959, 267 F.2d 102, 121 USPQ 364.

By contrast, the same circuit on two different occasions had indicated that it was only necessary for the Court to find the "ultimate" facts of invention or discovery, authorship, novelty and utility in *Galland-Henning Manufacturing Co. v. Logemann Bros. Co.,* 7 Cir. 1944, 142 F.2d 700, USPQ 466, and *Harley C. Loney Co., et al. v. Ravenscroft, et al.,* 7 Cir. 1947, 162 F.2d 703, 74 USPQ 47. The former case based its conclusion on a consideration of the case of *United States v. Esnault-Pelterie,* 340 U.S. 147, and in the latter case the Court commented,

> "If all ultimate facts are found and are substantially supported by evidentiary facts, *which of course need not be incorporated in the findings of fact,* then the court should conclude as a matter of law that the disclosure is patentable, otherwise not." (Italics supplied)

The issue is thus presented as to whether the ruling of the Supreme Court in the case of *United States v. Robert Esnault-Pelterie, supra,* was intended to be interpreted to encourage District Courts to make findings on the questions of authorship, ownership, novelty and utility, *without any discussion or findings as to "subordinate or circumstantial findings,"* as mentioned in the second case of the *United States v. Robert Esnault-Pelterie,* 303 U.S. 26.

Putting the matter in another way, would findings by the District Court *only* on such "ultimate facts" meet the test *in patent cases* expressed by the Supreme Court in the case of *Kelley v. Everglades Drainage District,* 319 U.S. 415, that

> "there must be findings, in such detail and exactness as the nature of the case permits, of *subsidiary* facts on which the ultimate conclusion of fairness can rationally be predicated. * * * We hold only that there must be findings, stated either in the court's opinion or separately, which are sufficient to indicate the factual basis for the ultimate conclusion."

The inquiry here is whether the Court used the designation "ultimate conclusion" in the sense in which it used the term "ultimate facts" in its statement in the *patent* case of *United States v. Robert Esnault-Pelterie,* 299 U.S. 201, that

> "validity and infringement are ultimate facts on which depends the question of liability."

In other words, would the Supreme Court support the rule in patent cases that was stated by the Ninth Circuit Court of Appeals in *Irish v. United States,* 9 Cir. 1955, 225 F.2d 3, that

> "Findings of fact are required under Rule 52(a), Federal Rules of Civil Procedure, 28 U.S.C.A. The findings should be so explicit as to give the appellate court a clear understanding of the basis of the trial court's decision, and to enable it to determine the ground on which the trial court reached its decision."

If this is the rule to be applied in patent cases the next question is whether the Ninth Circuit Court has followed this announced rule in the present case.

On petition for rehearing, as on the original appeal, defendants-petitioners urged that the findings of the District Court were inadequate. In the decision on rehearing Wollenberg, District Judge, stated,

> "The findings are detailed and complete in respect to prior art, time of invention, existence of competing machines, the nature of competing machines and comparison of functions; in short, novelty, utility and invention."

In view of the fact that no concept of the structures of the different machines of the three patents in suit, or of the Peelers commercial machine, or of the prior art machines, or of the alleged infringing Skrmetta machine can be obtained from a reading of the findings of fact, conclusions, District Court opinion, original Circuit Court opinion or Circuit Court opinion on rehearing, it is respectfully submitted that there is a most serious issue in this case as to how findings of fact in *patent cases* should be prepared and interpreted in order to enable the Appellate Court "to determine the ground on which the trial court reached its decision" announced as the objective of findings of fact by the Ninth Circuit, as quoted above.

Without the Trial Court having made adequate findings to constitute a proper basis for the "ultimate" facts it is not understood how the Appellate Court could have reviewed the basis for the decision of the lower court according to properly applicable rules of patent law. The decision of the Appellate Court verifies this contention because, while cases stating various precepts of patent law were recited by the Appellate Court, no application of these precepts was made to the *facts* of the present case, as was done by this Court in the case of *The Great Atlantic and Pacific Tea Company v. Supermarket Equipment Corp.*, 340 U.S. 147, for example.

The situation in this particular case is especially baffling because in four cases, three of which are very recent, the Ninth Circuit Court of Appeals has remanded patent cases to the District Court for more adequate findings. Those cases are,

Hycon Manufacturing Co. v. H. Koch & Sons, 9 Cir. 1955, 219 F.2d 353, 104 USPQ 231;

National Lead Company v. Western Lead Products Co., 9 Cir. 1961, 291 F.2d 447, 130 USPQ 4;

Welsh Co. of California v. Strolee of California, Inc., 9 Cir. 1961, 290 F.2d 509, 129 USPQ 175;

Hayes Spray Gun Company et al. v. E. C. Brown Company, 9 Cir. 1961, 291 F.2d 319, 129 USPQ 383.

CONCLUSION

It is respectfully submitted that it would be very undesirable for the principles followed in this case by the Ninth Circuit Court of Appeals to stand and it is therefore urged that this writ of certiorari be granted.

Respectfully submitted,

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